

Remarks/Arguments:

Claims 17-42, newly presented, are pending. Support for the present claims is indicated below.

Claims 1-16 are canceled, without prejudice or disclaimer.

Applicants wish to thank the examiner for the express indication of allowable subject matter, provided in the instant office action.

According to the office action (page 5) claims 3, 4, 6, 15, and 16 are free of the prior art and, accordingly, allowable if rewritten to overcome the rejection under §112, ¶ 2, and to include all limitations of the base claim and any intervening claims. In order to advance prosecution on the subject application, the present claims are limited to the subject matter found allowable by the examiner.

Specifically, the present claims 17, 21, 25, 29, and 36 correspond to allowable claims 3, 4, 6, 15, and 16, respectively, rewritten as independent claims. Additionally, present claims 18-20 correspond to claims 2, 5, and 7, respectively, rewritten to be dependent on present claim 17; present claims 22-24 correspond to claims 2, 5, and 7, respectively, rewritten to be dependent on present claim 21; present claims 26-28 correspond to claims 2, 5, and 7, respectively, rewritten to be dependent on present claim 25; present claims 30-35 correspond to claims 9-14, respectively, rewritten to be dependent on present claim 29; and present claims 37-42 correspond to claims 9-14, respectively, rewritten to be dependent on present claim 36. All of the present, dependent claims are

allowable (over prior art) as being dependent on allowable claims. *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988).

Claims 1-16 were rejected under 35 USC 112, 2nd paragraph, as allegedly being indefinite. Reconsideration is requested in view of the changes to the claims effected, hereby, taken in conjunction with the following remarks.

According to the statement of rejection the word "fenestrum" renders the rejected claims indefinite. As indicated by the examiner in the statement of rejection, the word "fenestra" was intended and, as such, is found in the present claims.

Note is taken that the statement of rejection mentions that claims 1 and 18 (allegedly) "are replete [with] idiomatic errors" but, accept for the word "fenestrum," no such errors are specifically indicated. It should be pointed out, with all due respect, merely that it requires some thought to understand the meaning of claim terminology does not render the terminology indefinite under § 112, ¶ 2. *S3 Inc. v. nVIDIA Corp.* 59 USPQ2d 1745 (Fed. Cir. 2001). Nevertheless, applicants are willing to consider further amendments to the claims, in order to advance prosecution, should the PTO specifically indicate any further claim terminology considered indefinite.

For the foregoing reasons, the rejection under § 112, ¶ 2, is overcome. Withdrawal of the rejections appears to be in order.

Claims 1-18 were rejected under 35 USC 101 as allegedly being directed to non-statutory subject matter. Reconsideration is requested.

According to the statement of rejection the claims are allegedly non-statutory as (allegedly) claims "a perilymph of the inner ear," which is a living tissue. With all due respect, "a perilymph of the inner ear" is not part of the invention of the rejected claims or the present claims.

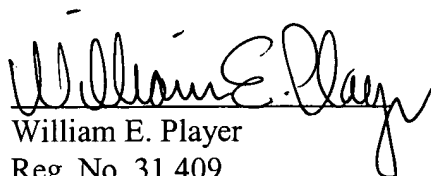
As found in original claim 1, present claim 17 recites (emphasis added) "an implantable device to be used as an artificial fenestra implantable in a bony wall of an inner ear, said device comprising . . . a membrane forming a barrier with a perilymph of said inner ear when applied in said bony wall." In other words, "a perilymph of said inner ear" is recited as a point of reference in a functional limitation on the recited "membrane" when the "device" is in use, i.e., the "membrane" must form "a barrier" with perilymph of the inner ear when the device is implanted in the bony wall of the inner ear. The perilymph of the inner ear does not constitute part of the presently claimed invention.

For the foregoing reasons, the rejection under § 101 is overcome. Withdrawal of the rejection appears to be in order.

The rejection of claims 1, 2, 4, 5, and 7-13 under 35 USC 102(b) and the rejection of claim 14 under 35 USC 103(a) are rendered moot by the instant amendment, which limits the claims to the subject matter found allowable by the examiner, as explained above. Withdrawal of the rejections under § 102(b) and § 103(a) appears to be in order.

Favorable action is requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "William E. Player", is written over a horizontal line.

William E. Player
Reg. No. 31,409
Attorney of Record

JACOBSON HOLMAN PLLC
400 Seventh Street, NW
The Jenifer Building
Washington, D.C. 20004
Tel. (202) 638-6666
Fax (202) 393-5350
Date: April 27, 2009
WEP/aer

Z:\WPLAYE\wep&secretary\2009\April\P70692US0 - Amendment.wpd